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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/281,710	03/30/99	OMURA	H 990204/LH

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MM92/0702

EXAMINER
JACKSON, C

ART UNIT	PAPER NUMBER
2881	

DATE MAILED: 07/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.

09/281,710

Applicant(s)

Hideyuki OMURA et al.

Examiner

Cornelius H. Jackson

Art Unit

2881

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on 26 April 2001 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Acknowledgement***

1. Acknowledgment is made that applicant's Amendment, filed on 26 April 2001, has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 <sup>and 4-10</sup> is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamakawa et al. ("Characteristics of Modulation Distortion of Fiber-Grating External-Cavity-Laser") in view of Pan et al. (5,892,781). Hamakawa et al. teach all stated limitations except intercepting means and its location. Pan et al. teach intercepting means **14** for intercepting reflected waves from the connector wherein the intercepting means is located on the optical path between the first Bragg grating section and the connector **Figs. 1A-B**. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Pan et al. to that of Hamakawa et al. to obtain a laser source with high output power and the precise output wavelength, **col. 1, line 48-58**.

In regards to claim 4, Pan et al. teach the intercepting means comprises an isolator, **see col. 4, lines 30-34**.

Art Unit: 2881

In regard to claims 5-8, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regard to claims 9-10, "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

### ***Response to Arguments***

4. Applicant's arguments filed 26 April 2001 have been fully considered but they are not persuasive. Applicant argues a first connector which output the light oscillated by the cavity is important to the arrangement to prevent light from returning from the connector ... thereby reducing the relative intensity of noise (RIN). Pan et al. teach the optical isolators at the output of each of the coupler/isolators 14 and 15 ensure that no light at any wavelength are reflected back, **see col. 5, lines 12-14**. Also in response to Applicant's argument that Pan et al. includes additional structure (connector) not required by Applicant's invention, it must be noted that the combination of Hamakawa et al. and Pan et al. disclose the invention as claimed. The fact that it discloses additional structure not claimed is irrelevant.

5. In response to Applicant's argument that Pan et al. does not teach placement of the isolator. Pan et al. shows the placement of the isolator in Figs. 1A-B.

6. In response to Applicant's argument that Pan et al. does not teach RIN reduction, **see col. 5, lines 12-22**.

Art Unit: 2881

7. In response to Applicant's argument that Pan et al. does not teach forming part of an external cavity by means of a laser light emitting device. Examiner stated that Hamakawa et al. teach forming part of an external cavity by means of a laser light emitting device.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cornelius H. Jackson whose telephone number is (703)306-5981. The examiner can normally be reached on 8:30 - 4:00, Monday - Friday.


Art Unit: 2881

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa M. Arroyo can be reached on (703)308-4782. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7722 for regular communications and (703)308-7721 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

  
chj

July 2, 2001

  
TERESA M. ARROYO  
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